

REMARKS

Claims 1-25 are pending in the application. Claim 1 is amended to correct a minor informality. No new matter has been added.

The Examiner rejected claims 1-25 under 35 U.S.C. 103(a) as allegedly being unpatentable over in view of Hasebe et al. (US 20030103002A1) in view of Feigen (US 20010041961A1). Applicant traverses.

The following remarks are for independent claim 1 but apply by analogy to independent claims 9, 16 and 21.

The Examiner recognized that Hasebe was deficient vis-à-vis claim 1 and indicated that “although Hasebe mentions about the memory devices (3, 4)...Hasebe does not teach that such storage unit for storing information on directions between major cities of all the nations and the specific location. Hasebe does not disclose a direction searching command for searching a direction to the specific location with a current city information setup by user.” (Office Action, pages 3 and 4).

Because of the deficiencies in Hasebe, the Examiner applied Feigen and alleged that Feigen teaches “a navigation system (202) (Feigen, figure 2, 202)...including a database for storing lists of cities that refer to any kind of place or municipality, including but not limited to cities, towns, villages, hamlets, states, counties, province, countries, townships, postal zones, areas codes, etc. Feigen further discloses a window display for displaying a list of cities for user to select during a selection set-up.” (Office Action, page 4).

Applicant submits (1) there is no motivation to combine the applied references together, and (2) even if combined, the applied references would not lead to the features of claim 1.

Although Feigen may provide driving directions via a map to navigate to a specified location, Feigen’s directions to the specified location would not assist a user when attempting to find Mecca as described in Hasebe. Even if the navigation system were used in Feigen, a user who wants to pray in the direction of Mecca would not be able to use the navigation system to find which direction to face when praying. That is, being able to drive to Mecca, via a route

given by the navigation system in Feigen would be of no use to a user who wants to pray in the direction of Mecca, as described in Hasebe. In other words, being given a picture of a map with highlighted streets to turn on does not help a user who is not driving anywhere, when the user wants to know where Mecca is from his current location. Even though the user may know how to drive to Mecca, he still would be unable to know which direction Mecca is located when it is time to pray towards Mecca. Incidentally, this evidences that the teachings of Feign do not compensate for the deficiencies of Hasebe.

Consequently, there is no motivation to combine the teachings of Feigen that give street directions to a specified location for driving in a car, with the teachings of Hasebe that describe a user who wants to face toward a particular location, but not drive there. Further, each reference is complete and functional in itself, so there would be no reason to use parts from or add substitute parts to any reference.

Nevertheless, even if combined, the street directions (map) of Feigen would be of no use to a user who desires to face toward a particular direction (Mecca). Thus, the combined teachings of Hasebe and Feigen do not teach or suggest "a storage unit for storing information directions between major cities of all the nations and the specific locations...[nor] a control unit, upon transmission of the direction searching command from the input unit, for indicating the orientation of a portable device and...the direction information between the current city information setup though the input unit and the specific location stored in the storage unit." Modifying Hasebe to have the navigation system of Feigen would cause Hasebe to be inoperable for its intended purpose, because the user may have instructions on driving to Mecca based on Feigen, but not have the proper direction in which to face for prayer as desired in Hasebe.

Furthermore, "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.); (*See* MPEP 2143.01). The mere fact that references can be

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); (*See* MPEP 2143.01). There is no suggestion that Hasebe be modified in the manner suggested by the Examiner.

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); (*See* MPEP 2143.01).

The Examiner recognized to some extent that the two references do not suggest the alleged combination. The Examiner then posited that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hasebe to include the teachings as taught by Feigen so that one user [who] has no knowledge about geographic or experience about navigating from one location to another can reach a location without getting lost [emphasis added]." (Office Action, page 4). The Examiner's reason for modifying Hasebe, by the teachings of Feigen, does not compensate for the deficiencies in Hasebe and provides no assistance to a user described in Hasebe. That is, a user of the device in Hasebe is not *traveling to Mecca*, so information about how to navigate to Mecca would be of no consequence. Indeed, the ***user is not getting lost*** because the user is not going anywhere. Thus, Applicant submits that one skilled in the art has no reason to modify Hasebe by the teachings of Feigen.

For the reasons discussed above, the combination of Hasebe and Feigen does not render obvious the unique features of independent claims 1, 9, 16, or 21, nor their respective dependent claims 2-8, 10-15, 17-20, and 22-24. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection of claims 1-25.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/767,469

Attorney Docket No. Q79516

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

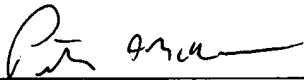
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